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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/923,954

Applicant(s)

SIMPSON ET AL.

Examiner

James H. Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) <u>6</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The usage of the term "imaging client" is never clearly defined in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase "and/or" in these claims is indefinite. For purposes of examination, the phrase "and/or" is interpreted as "or".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-11, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nehab et al. (hereinafter Nehab, U.S. Patent No. 6,029,182).

In regard to independent Claim 1 (and similarly independent Claims 14, and 15), Nehab teaches WebFormatter. Nehab also teaches that when a user clicks on the icon for container (76), menu (77) is displayed. Menu (77) provides five options; i.e., Open (79), Empty (80), Print (81), Edit (82) and Save (84). These options are highlighted when activated (Col. 15, lines 66-67; Col. 16, lines 1-2). Open (79), when activated, displays Container Contents screen (87) shown in Fig. 9B. Container Contents screen (87) shows the URL addresses stored in container (76). Container contents screen (87) provides four buttons; i.e., Add current URL button (88) which adds the current URL to container (76), Delete button (89) which permits a user to highlight and delete a URL in container (76), Empty button (90) which permits a user to empty container (76), and Done button (91) which permits a user to close Container Contents screen (87) (Col. 16, lines 4-12). Nehab also teaches that Print (81), Edit (82) and Save (84), when activated (*receiving a request for a single composition composed of information from a plurality of different sources*), cause WebFormatter to download all data (*retrieving the information from each of a plurality of different sources*) at Web pages defined by the URLs stored in container (76), format them as specified by the user, create RTF file(s) (*creating the*

single composition by including the retrieved information into a composition) storing the formatted Web pages, and do the selected action, i.e., save, edit or print the RTF file(s) *(using the single composition)* (Col. 16, lines 21-26).

In regard to dependent Claim 2, Nehab teaches that container contents screen (87) provides four buttons; i.e., Add current URL button (88) which adds the current URL to container (76), Delete button (89) which permits a user to highlight and delete a URL in container (76), Empty button (90) which permits a user to empty container (76), and Done button (91) which permits a user to close Container Contents screen (87) (Col. 16, lines 4-12; compare with Claim 2, “... ***the obtaining step comprises obtaining a reference to information at a different web site***”).

In regard to dependent Claim 4, Nehab teaches a data retrieval system which can retrieve articles from a news service, from a magazine service, or from a combination of both services which are located on the World Wide Web, a private computer network that supports hypermedia links, or any other hypermedia-linked computer system (Col. 1, lines 13-19; compare with Claim 4, “... ***each of a plurality of the different sources are on different web sites from said assembling web site***”).

In regard to dependent Claim 5, Nehab teaches a data retrieval system which can retrieve articles from a news service, from a magazine service, or from a combination of both services which are located on the World Wide Web, a private computer network that supports hypermedia links, or any other hypermedia-linked computer system (Col. 1, lines 13-19; compare with Claim 5, “... ***the obtaining step***”).

comprises accessing at least two different web sites and retrieving information therefrom").

In regard to dependent Claim 6, Nehab teaches that WebFormatter is stand-alone utility software that can be used in conjunction with different Web browsers, such as Netscape, Mosaic and Internet Explorer (*all imaging clients*). In short, WebFormatter extracts data from a Web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor, such as MS Word, WordPerfect, Wordpad, etc. (Col. 13, lines 21-30; compare with Claim 6, "***... the obtaining step comprises correlating the input information and/or selections from the imaging client to the plurality of different sources***").

In regard to dependent Claim 7, Nehab teaches that WebFormatter is stand-alone utility software that can be used in conjunction with different Web browsers, such as Netscape, Mosaic and Internet Explorer. In short, WebFormatter extracts data from a Web page, strips out extemporaneous data from the extracted data, and reformats the data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor, such as MS Word, WordPerfect, Wordpad, etc (Col. 13, lines 22-30; compare with Claim 7, "***... the receiving a request step comprises serving up content including a user interface to a user's browser to allow the input of information and/or selections***").

In regard to dependent Claim 8, Nehab teaches in Figs. 4 and 5 the process by which personal-news-profile (19) is defined. To create personal-news-profile (19), personal-news-profile editor (16) communicates with personal-news-profile (19), site profile (20), and Web reader (34). Personal-news-profile (19) contains information as to what sites to access for creating a personalized newspaper, what sections to retrieve from those sites, rules to be used to determine what data to extract from the sections and the articles therein, rules to determine how to exclude links, and newspaper format information (Col. 7, lines 23-34; compare with Claim 8, “... ***the single composition designates a reference and/or information from one of the different sources for a different location in the composition relative to the reference and/or information from another of the different sources***”).

In regard to dependent Claim 9, Nehab teaches that in alternative embodiments of WebFormatter, a filename can also be entered into URL address field (44). For example, in these alternative embodiments, if a user wishes to format a hyper-linked manual into a book-like format, the user enters the filename into URL address field (44). Thereafter, WebFormatter proceeds through the file in the same manner as through specified Web pages in order to reformat the hyper-linked manual as desired (Col. 14, lines 36-42; compare with Claim 9, “... ***at least one of the sources is a file***”).

In regard to dependent Claim 10, Nehab teaches that WebFormatter is stand-alone utility software that can be used in conjunction with different Web browsers, such as Netscape, Mosaic and Internet Explorer. In short, WebFormatter extracts data from a Web page, strips out extemporaneous data from the extracted data, and reformats the

data into a formatted document. The formatted document can then be printed, stored in an RTF (Rich Text Format) file, or edited in any RTF compatible editor, such as MS Word, WordPerfect, Wordpad, etc (Col. 13, lines 22-30; compare with Claim 10, “... ***the using step comprises serving the composition to an imaging client***”).

In regard to dependent Claim 11, Nehab teaches that the invention also provides a method for synthesizing all retrieved news articles and printing the synthesized news articles into a newspaper-type format in which each of the articles is arranged based on a user's predefined layout (Col. 1, lines 30-34; compare with Claim 11, “... ***the using step comprises printing the composition***”).

In regard to dependent Claim 13, Nehab teaches that by clicking on an appropriate icon on graphical user interface (116) (which, in Fig. 9E, includes icons identical in both structure and function to those shown in graphical user interface (43)), the user can capture the current Web page, process and format the Web page into an RTF file, and save, edit and/or print the RTF file (Col. 18, lines 25-30; compare with Claim 13, “... ***the using step comprises storing the composition***”).

Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (hereinafter Anderson, U.S. Patent No. 6,567,122).

In regard to independent Claim 16, Anderson teaches images stored in a digital image capture unit (*an imaging source for creating graphic data*) including an imaging device and a display. The image capture unit (i.e. digital camera) is used to capture images and store them within its internal memory. The image capture unit accesses an

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ID server via the Internet and registers its identity and Internet address with the web server. A user subsequently accesses the image capture unit by entering the identity of the image capture unit into his web browser. The web browser, using standard Internet protocols, then queries the ID server with the identity of the image capture unit and retrieves the Internet address. The Internet address is subsequently used to access a web page hosted by the image capture unit and display the web page to the user. The web page provides access to the stored images within the image capture unit (Abstract; compare with Claim 16, ***“... a graphics store integrated with the imaging source so that internal data of the imaging source relating to individual graphics is accessible thereto”***).

In regard to dependent Claim 17, Anderson teaches that the Internet address is subsequently used to access a web page hosted by the image capture unit and display the web page to the user. The web page provides access to the stored images within the image capture unit (Abstract; compare with Claim 17, ***“... a website connected to the imaging source”***).

In regard to independent Claim 18, Anderson teaches that the image capture unit (e.g., a digital camera) is used to capture images and store them within its internal memory. The image capture unit accesses an ID server via the Internet and registers its identity and internet address with the web server. A user subsequently accesses the image capture unit by entering the identity of the image capture unit into his web browser. The web browser, using standard Internet protocols, then queries the ID server with the identity of the image capture unit and retrieves the Internet address. The

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Internet address is subsequently used to access a web page hosted by the image capture unit and display the web page to the user. The web page provides access to the stored images within the image capture unit (Abstract; compare with Claim 18, “... ***creating a graphic with internal graphic data relating thereto; and providing remote web access to the internal graphic data***”).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab.

In regard to dependent Claim 3, Nehab does not specifically teach that *information is generated dynamically at the different web site, when the web site is accessed*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to assume that any one or more of the URL's specified in Nehab's Container Contents screen (87) (shown in Fig. 9B) could have pointed to a web site whose pages were generated dynamically either in part or as a whole since Nehab's invention specifically deals with the generation of a personalized Newspaper; the content of news sources is commonly dynamic just as news itself is dynamic. The benefit would have been to provide the latest information to the user.

In regard to dependent Claim 12, Nehab does not teach that *the using step comprises sending the composition by email to a designated web site*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to email the composition, just as one can email other documents, graphics, audio and

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video to a web site capable of handling email, allowing for the efficient transport of the contents of a composition to another web site for possible posting.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
10/29/04



SANJIV SHAH
PRIMARY EXAMINER